FILED
FEB 4 1928

In the Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,
Petitioner,

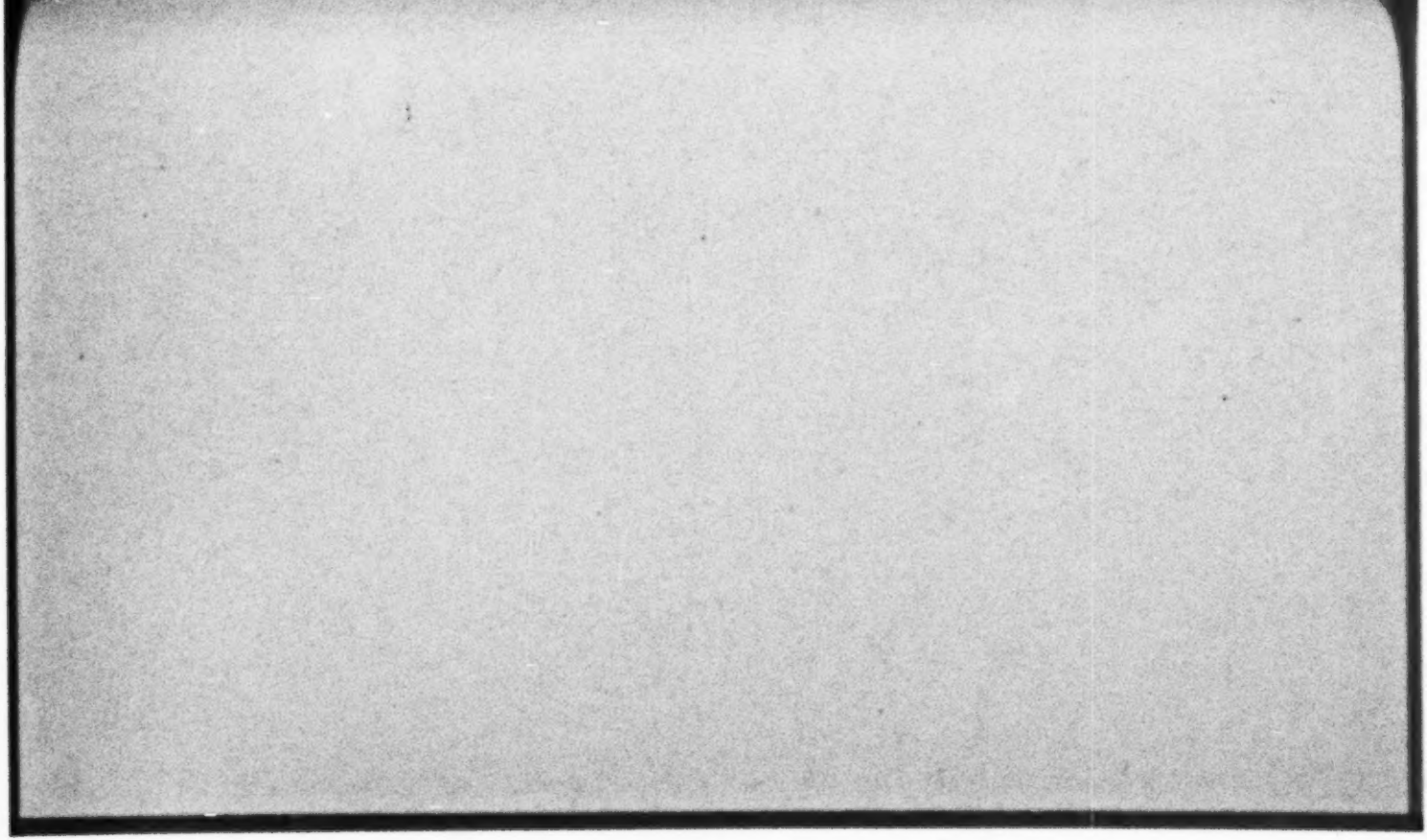
vs.

GRIGGS-COOPER AND COMPANY,
Respondent.

BRIEF ON BEHALF OF PETITIONER

FRANK F. DINSMORE,
Union Central Bldg., Cincinnati, Ohio,
WALTER F. MURRAY,
First National Bank Bldg., Cincinnati, Ohio,
Attorneys for Petitioner.

COBB, HOWARD & BAILEY,
Blymer Bldg., Cincinnati, Ohio,
MORPHY, BRADFORD, CUMMINS, CUMMINS & LIPSCHULTZ,
360 Robert St., St. Paul, Minn.,
Attorneys for Respondent.



SUBJECT INDEX

	PAGE
This Court's writ of certiorari issued to Supreme Court of Ohio	1
Supreme Court of Ohio held that Registration of Trade-Mark in Patent Office under Trade-Mark Act of 1905, extended rights of registrant into states in which it had no trade	2
Section of Trade-Mark Act	2
Statement of Case	1
Assignment of Errors	3
Summary	4
Argument	4
Conclusion	9

TABLE OF CASES

Ammon & Person v. Narragansett Dairy Co., 262 Fed. Rep. 881	8
Andrew Jergens Co. v. Woodbury, 273 Fed. Rep. 952	8
Robertson, Commissioner of Patents, ex rel., Baldwin Piano Co., 287 Fed. Rep. 943	8
General Baking Company v. Gorman, 3 Fed. Rep. 2nd, p. 894	7
Hanover Star Milling Company v. Metcalf, 240 U. S. 425	5, 6
Trade Mark Cases, 100 U. S., p. 93	4, 6
United Drug Co. v. Rectanus, 248 U. S. 100	5
Waldes v. International Mfrs. Agency, 237 Fed. Rep. 506	8

OFFICIAL REPORT OF OPINION BELOW

United States Printing & Lithograph Co. v. Griggs-Cooper & Co., 162 N. E. 425	2, 3

In the Supreme Court of the United States

OCTOBER TERM, 1928

No. 372

THE UNITED STATES PRINTING AND LITHOGRAPH COMPANY,

Petitioner,

vs.

GRIGGS-COOPER AND COMPANY,

Respondent.

BRIEF ON BEHALF OF PETITIONER

STATEMENT

This case, which comes before this Court pursuant to a writ of certiorari issued to the Supreme Couurt of Ohio, was brought by the Respondent, Griggs-Cooper and Company in the Common Pleas Court of Hamilton County, Ohio, against the Petitioner, The United States Printing & Lithograph Company, for alleged infringement of a trade-mark "Home" for groceries.

The writ was applied for and granted for the reason that the decision of the Supreme Court of Ohio was rendered in favor of Respondent, upon the ground that regis-

tration by the Respondent of the trade-mark "Home" in the United States Patent Office under the Trade-Mark Act of 1905, extended the rights of the Respondent therein, into states, in which the Respondent had not done business, under the trade-mark. (R. p. 10.)

Respondent's trade under the trade-mark "Home" had been in certain specified states and Petitioner for many years had sold labels bearing trade-marks, comprising the word "Home," to its customers, grocers located in states other than those in which Respondent had sold its goods. The states in which Respondent sold its goods under the trade-mark "Home" were Minnesota, Wisconsin, Iowa, North Dakota, South Dakota, Montana and Washington. The states in which Petitioner's customers for said labels were located were Kansas, Illinois, Indiana, Pennsylvania, Missouri, Ohio, Michigan, Virginia, Maryland and Louisiana. (R. pp. 7 and 8.)

The Supreme Court of Ohio quoted Section 16 of the Trade-Mark Act of 1905, viz:

> "The registration of a trade-mark under the provisions of this subdivision of this chapter shall be *prima facie* evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels * * * intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several states, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof." (R. p. 14.)

and construed it as follows:

> "It is our opinion that the purpose and effect of this statute was to project the trade-mark rights of the registrant and owner thereof into all the states even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner.
>
> The provisions of the act of 1905 so interpreted and applied are not violative of the Federal Constitution, but are authorized by Section 8 of Article I thereof, wherein power is conferred upon Congress 'to regulate commerce with foreign nations, and among the several states, and with the Indian tribes.' There is ample ground for the contention that the purpose of the passage of the act of 1905 was to put trade-marks on the same basis as patents, and to afford them like protection." (R. p. 16.)

The Court therefore affirmed the decision that enjoined Petitioner from printing labels for its said customers.

ASSIGNMENT OF ERRORS

It is intended to urge:

1. That the Supreme Court of Ohio erred in holding that the Registration of Respondent's Trade-Mark in the United States Patent Office under the Trade-Mark Act of 1905, extended Respondent's rights in the trade-mark into states in which it had made no sales, and in advance of its trade in those states.

2. That the Supreme Court of Ohio erred in holding that the Registration of Respondent's trade-mark in the United States Patent Office under the Trade-Mark Act of 1905, extended Respondent's rights in the trade-mark into states in which it had made no sales, in advance of its trade in those states, and in derogation of the rights of others, who were first to use the trade-mark in the sale of their goods in those states.

SUMMARY

The effect of this ruling of the Supreme Court of Ohio is that a grocer who had sold his goods under the name "Home" solely in the north-western states, by securing registration of the word in the Patent Office, could prevent grocers who were selling their goods under names such as "Harvest Home" and "Home Run," in states remote from the north-western states, from getting labels printed for use on their goods, under their trade-marks.

ARGUMENT

This Court has decided how trade-mark rights are created, and what the powers of Congress over these rights are, but has not had before it the specific question as to whether the Trade-Mark Act of 1905 extended the trade-mark rights of a registrant into states in advance of the extension of the trade therein. It is thought, however, that the decisions of this Honorable Court, in construing earlier trade-mark acts, indicate that the Trade-Mark Act of 1905 can not have the effect given to it by the Supreme Court of Ohio in this case.

This Court has decided that:

A.

The property in trade-marks and the right to their exclusive use rest on the laws of the states. In *Trade-Mark Cases*, 100 U. S., at page 93, Mr. Justice Miller said:

> "The property in trade-marks and the right to their exclusive use resting on the laws of the states in the same manner that other property does, and depending like the great body of the rights of person and of property for their security and protection on those laws, the power of Congress to legislate on the subject to establish the conditions on which these rights

shall depend, the period of their duration, and the legal remedies for their protection, if such power exist at all, must be found in some clause of the Constitution of the United States, the instrument which is the source of all the powers that Congress can lawfully exercise."

B.

Trade-mark rights, resting on the laws of the states, are limited to states in which the trade-marks are used.

In *Hanover Star Milling Company* v. *Metcalf*, 240 U. S. at page 425, Mr. Justice Holmes (concurring) said:

> "The question then is, what is the common law of Alabama in cases like these? It appears to me that if a mark previously unknown in that state has been used and given a reputation there, the state may well say that those who have spent their money innocently in giving it its local value are not to be defeated by proof that others have used the mark earlier in another jurisdiction more or less remote."

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. at page 100, Mr. Justice Pitney said:

> "Property in trade-marks and the right to their exclusive use rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate upon the subject being only such as arises from the authority to regulate commerce with foreign nations and among the several states and with Indian tribes. (Page 98.) • • •
>
> It would be a perversion of the law of priority to give it such an application in our broadly extended country, that an innocent party, who had in good faith employed a trade-mark in one state, and by use of it had built up a trade there, being the first appropriator in that jurisdiction, might afterwards be prevented from using it with consequent injury to his trade and good-will at the instance of one who theretofore had

employed the same mark, but only in other and remote jurisdictions, upon the ground that its first employment happened to antedate that of the first mentioned trader."

C.

Congress has been given no right to legislate upon the substantive law of trade-marks.

In *Trade-Mark Cases*, 100 U. S. 93, speaking of the United States Trade-Mark Act of 1870, Mr. Justice Miller said at page 96:

> "There still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same state, is beyond the control of Congress.
>
> When, therefore, Congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the statute, or from its essential nature, that it is a regulation of commerce with foreign nations, among the several states, or with the Indian tribes. If it is not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it is apparent that it is designed to govern the commerce wholly between citizens of the same state, it is obviously the exercise of a power not confided to Congress."

In *Hanover Star Milling Co.* v. *Metcalf*, Mr. Justice Pitney said at page 416, 240 U. S.:

> "And so far as the controversy concerns intrastate distribution as distinguished from interstate trade, the subject is not within the sovereign powers of the United States."

It is submitted that the ruling of the Supreme Court of Ohio that registration under the Trade-Mark Act of 1905

extends the rights of the registrant into states in which registrant has done no business, is not in accord with decisions of this Court above classified under headings A, B and C.

The point of law in issue has been decided in a way opposite to that of the Supreme Court of Ohio by United States Circuit Court of Appeals and by United States District Courts.

In *General Baking Company* v. *Gorman*, 3 Fed. Rep. 2nd, 893-894, the plaintiff had registered its trade-mark under the Trade-Mark Act of 1905. Plaintiff's contention that its rights were thereby projected in advance of its trade was answered by the United States Circuit Court of Appeals of the First Circuit, thus:

> "Plaintiff's learned counsel contend that the federal registration of its trade-mark in 1916 gave it a practically unlimited right of expansion, so that local bakers were thereafter charged with knowledge of its purpose to introduce in their communities "Bond" bread, and were therefore prevented from adopting any trade-name which might conceivably infringe upon the "Bond" trade-mark. This contention, on analysis, falls little short of making federal registration of a trade-mark the equivalent of a patent or a copyright —a far-reaching proposition we can not adopt. Nothing is better settled than that rights in trade-marks are of common-law origin, and are always 'apurtenant to an established business or trade in connection with which' they are employed. See *Trade-Mark Cases*, 100 U. S. 82, 25 L. ed. 550; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, 524. Rhode Island can not be deprived of the power to protect its citizens in the good will of their business by federal registration of a trade-mark for interstate commerce."

That registration confers no rights that the registrant did not have under common law is thus stated by Judge

Learned Hand in *Waldes* v. *International Mfrs. Agency*, 237 Fed. Rep. 502-506:

> "Registration confers no right, and limits none; it is a mere procedural advantage, depending upon common-law 'ownership,' which can exist quite as well without it."

A similar finding by Chief Justice Smyth of the Court of Appeals of the District of Columbia, is found in *Robertson, Commissioner of Patents*, v. *United States, ex rel., Baldwin Co.*, 287 Fed. Rep. 943, viz:

> "Registration of a mark conveys no property right * * * and its cancellation takes none away. Ownership of the mark depends upon its adoption and use, not on its registration. * * * The only effect of registration is to raise a rebuttable presumption in favor of the registrant's ownership."

In *Andrew Jergens Co.* v. *Woodbury*, 273 Fed. Rep. 952, at page 965, Judge Morris said:

> "The complainant caused a combination mark consisting of the word 'Woodbury's' and the neckless head, to be registered for use upon some of the commodities which it claims through the assignment of the trustee dated March 6, 1909; but under the facts of this case such registration neither conferred any greater rights in the use of that name or mark upon the complainant, nor diminished the rights of others entitled to the use thereof."

In *Ammon & Person* v. *Narragansett Dairy Company*, Judge Anderson, in the United States Court of Appeals of the First Circuit, 262 Fed. Rep. 880, said at page 881:

> "While the plaintiff had registered 'Queen' as its trade-mark, we agree with the court below that the case must be determined on common-law principles and that no rights now in question have been acquired out of registration."

CONCLUSION

We submit that the rights of the Respondent in the trade-mark "Home" are limited by the boundaries of the states in which it has sold its goods thereunder, were not extended into the states in which it had made no sales, that Petitioner in printing and selling labels bearing the trade-mark "Home" to grocers in the states last mentioned, did not infringe any trade-mark rights of the Respondent, and that the decree enjoining Petitioner from such printing and selling should be reversed.

Respectfully submitted,

FRANK F. DINSMORE, and
WALTER F. MURRAY,
Of Counsel for Petitioner.